REMARKS

Reconsideration of the present application is respectfully requested in view of the following remarks. Prior to entry of this response, Claims 1-15 and 18-20 were pending in the application, of which Claims 1 and 15 are independent. In the Final Office Action March 1, 2007, Claims 1-15 and 18-20 were rejected under 35 U.S.C. § 103(a). Following this response, Claims 1-15 and 18-20 remain in this application. Applicant hereby addresses the Examiner's rejections in turn.

I. Interview Summary

Applicant thanks Examiner Lesniewski for the courtesy of a telephone interview on March 29, 2007, requested by the undersigned to discuss the rejection of the current claims under 35 U.S.C. § 103. During the interview, Applicants asserted that the cited references do not anticipate or render obvious the claims as currently amended. No agreement we reached regarding patentability although the Examiner agreed that the amendments to Claim 15 get around the cited references.

II. Rejection of the Claims Under 35 U.S.C. § 103(a)

In the Final Office Action dated March 1, 2007, the Examiner rejected Claims 1-4 and 11-14 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,529,187 ("*Dickelman*") in view of U.S. Patent No. 6,009,459 ("*Belfiore*") further in view of U.S. Patent No. 5,977,969 ("*DiAngelo*"). Applicant respectfully traverses this rejection because combining the aforementioned references would not have led to the claimed invention.

-8-

Claim 1 is patentably distinguishable over the cited art for at least the reason that it recites, for example, "determining, when it is determined that the one character of text does not comprise the single word, whether a combination of the one character of text and the another character of text comprises the single word wherein determining whether the combination of the one character of text and the another character of text comprises the single word comprises determining, prior to receiving yet another character of text, that the another character of text comprises the character other than a period." Support for this amendment can be found in the specification at least on page 10, lines 4-10.

The Examiner stated that *Dickelman* and *Belfiore* do not "explicitly disclose reiterating the receiving and determining steps for each character." (See Office Action, page 4, lines 3-4.) The Examiner further stated that the practice of iteration is common in the computer arts. (See Office Action, page 4, lines 4-5.) As a result, Applicant respectfully suggests that the Examiner has failed to make a *prima facie* case of obviousness. In order to make a *prima facie* case of obviousness, the Examiner must set forth prior art that teach or suggest every claim limitation. (See MPEP § 2143.) There is nothing in the references cited by the Examiner that discloses "determining, when it is determined that the one character of text does not comprise the single word, whether a combination of the one character of text and the another character of text comprises the single word wherein determining whether the combination of the one character of text and the another character of text comprises the single word comprises determining, prior to receiving yet another character of text, that the another character of text comprises the character other than a period," as recited by Claim 1. Accordingly,

independent Claim 1 patentably distinguishes the present invention over the cited art, and Applicant respectfully requests withdrawal of this rejection of Claim 1.

If the Examiner continues to rely on this unsupported contention, Applicant respectfully requests the Examiner to provide support. See, In re Zurko, 258 F.3d 1379, 59 U.S.P.Q.2d 1693 (Fed. Cir. 2001) (holding that the USPTO must point to some concrete evidence in the record to support core factual findings in a determination of patentability); Memorandum by Stephen G. Kunin, Deputy Commissioner for Patent Examination Policy (February 21, 2002)(stating that it is never appropriate to rely on common knowledge without evidentiary support as sole or principal evidence on which to base rejection); 37 C.F.R. § 1.104 (providing that when a rejection in an application is based on facts within the personal knowledge of an Examiner, the data should be stated as specifically as possible, *and the facts must be supported*, when called for by the applicant, by an affidavit from the Examiner); MPEP § 2144.03 (providing that the Examiner may only take official notice of facts outside of the record which are capable of instant and unquestionable demonstration as being "well-known" in the art and, if the Applicant traverses such an assertion, the Examiner *should cite a reference* in support of his or her position.).

As stated above, the Examiner stated that *Dickelman* and *Belfiore* do not explicitly disclose "reiterating the receiving and determining steps for each character." (See Office Action, page 4, lines 3-4.) Furthermore, Applicant respectfully submits that *DiAngelo* does not overcome *Dickelman's* and *Belfiore's* deficiencies. *DiAngelo* merely discloses that a user's subsequent entry of characters 318 from a keyboard or virtual keyboard is reflected within an entry box 304. (See col. 4, lines 37-39.) Each character

is displayed in *DiAngelo* within entry box 304 as it is displayed, with an insertion point 306 being moved to a point following a last entered character to reflect a new insertion point. (See col. 4, lines 39-43.) Like *Dickelman* and *Belfiore*, *DiAngelo* at least does not teach or suggest searching a history folder comprising universal resource locators previously viewed by a user from a web browser program module. Rather *DiAngelo* merely discloses a user's character entry from a keyboard is reflected within an entry box.

In short, combining *Dickelman*, *Belfiore*, and *DiAngelo* would not have led to the claimed invention because *Dickelman*, *Belfiore*, and *DiAngelo*, either individually or in combination, at least do not disclose or suggest "determining, when it is determined that the one character of text does not comprise the single word, whether a combination of the one character of text and the another character of text comprises the single word wherein determining whether the combination of the one character of text and the another character of text comprises the single word comprises determining, prior to receiving yet another character of text, that the another character of text comprises the character other than a period," as recited by Claim 1. Accordingly, independent Claim 1 patentably distinguishes the present invention over the cited art, and Applicant respectfully requests withdrawal of this rejection of Claim 1.

Dependent Claims 2-14 are also allowable at least for the reasons described above regarding independent Claim 1, and by virtue of their dependency upon independent Claim 1. Accordingly, Applicant respectfully requests withdrawal of this rejection of dependent Claims 2-14.

III.   Rejection of the Claims Under 35 U.S.C. § 103(a)

In the Final Office Action, the Examiner rejected Claims 5-10, 15, and 18-20 under 35 U.S.C. § 103(a) as being unpatentable over *Dickelman* in view of *Belfiore* in view of *DiAngelo* in view of U.S. Patent No. 6,392,640 ("*Will*"). Claim 15 has been amended, and Applicant respectfully submits that the amendment overcomes this rejection and adds no new matter.

Amended Claim 15 is patentably distinguishable over the cited art for at least the reason that it recites, for example, "searching, when it is determined that the one character of text comprises the single word, a history folder in the electronic device to find at least one address with the one character of text, the history folder comprising universal resource locators previously viewed by a user from a web browser program module." Support for this amendment can be found in the specification at least on page 10, lines 11-14.

In contrast, and as stated by the Examiner, any reasonable combination of *Dickelman*, *Belfiore*, and *DiAngelo* at least does not teach or suggest the aforementioned recitation. For example, as stated by the Examiner, *Dickelman*, *Belfiore*, and *DiAngelo* do not explicitly state searching a history folder to find matches to the entered characters. (*See* Office Action, page 7, paragraph 15.) Furthermore, Applicant respectfully submits that *Will* does not overcome *Dickelman's*, *Belfiore's*, and *DiAngelo's* deficiency. *Will* merely discloses a method for entering words with a menu and thumbwheel. (*See* Abstract, line 1.) The system in *Will* can learn which words a particular user is likely to speed entry. (*See* Abstract, lines 13-14.) The approach in *Will* is applicable to word entry to compose natural language text as well as name entry,

-12-

electronic mail, and Web addresses for use with electronic mail, directory lookup, and Web browsing. (See Abstract, lines 14-18.) *Will's* FIG. 14A shows a personal digital assistant screen just before calculations are made to determine whether the user should be presented with an opportunity to disambiguate a particular previously entered character group. (See col. 14, lines 3-6.) In this case in *Will*, it is better to disambiguate an existing letter rather than enter a new letter more than half the time particularly given that the system requests a disambiguation of only that character group that has the greatest effect. (See col. 14, lines 11-15.) Like *Dickelman*, *Belfiore*, and *DiAngelo*, *Will* at least does not teach or suggest determining, prior to receiving yet another character of text, that the another character of text comprises the character other than a period. Rather *Will* merely discloses a personal digital assistant determining whether to presented to a user an opportunity to disambiguate a particular previously entered character group.

In short, combining *Dickelman*, *Belfiore*, *DiAngelo* and *Will* would not have led to the claimed invention because *Dickelman*, *Belfiore*, *DiAngelo* and *Will*, either individually or in combination, at least do not disclose or suggest "searching, when it is determined that the one character of text comprises the single word, a history folder in the electronic device to find at least one address with the one character of text, the history folder comprising universal resource locators previously viewed by a user from a web browser program module," as recited by amended Claim 15. Accordingly, independent Claim 15 patentably distinguishes the present invention over the cited art, and Applicant respectfully requests withdrawal of this rejection of Claim 15.

Dependent Claims 18-20 are also allowable at least for the reasons described above regarding independent Claim 15, and by virtue of their respective dependencies upon independent Claim 15. Accordingly, Applicant respectfully requests withdrawal of this rejection of dependent Claims 18-20.

IV. Conclusion

Applicant respectfully requests that this Amendment After Final be entered by the Examiner, placing the claims in condition for allowance. Applicant respectfully submits that the proposed amendments of the claims do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Finally, Applicant respectfully submits that the entry of the Amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicant respectfully submits that the claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant therefore requests the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

In view of the foregoing, Applicant respectfully submits that the pending claims, as amended, are patentable over the cited references. The preceding arguments are based only on the arguments in the Official Action, and therefore do not address

patentable aspects of the invention that were not addressed by the Examiner in the Official Action. The claims may include other elements that are not shown, taught, or suggested by the cited art. Accordingly, the preceding argument in favor of patentability is advanced without prejudice to other bases of patentability. Furthermore, the Final Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Final Office Action.

Please grant any extensions of time required to enter this amendment and charge any additional required fees to our Deposit Account No. 13-2725.

Respectfully submitted,

MERCHANT & GOULD P.C.

P.O. Box 2903
Minneapolis, MN 55402-0903
404.954.5066

/s/ D. Kent Stier/

Date: May 1, 2007

DKS:mdc

D. Kent Stier
Reg. No. 50,640

27488
PATENT TRADEMARK OFFICE